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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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United Country Real Estate, Inc., by change of name from
First Horizon Corporation

v.

Christopher B. Colwell

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Opposition No. 91158548
to application Serial No. 78181779
filed on November 5, 2002

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Thomas H. Van Hoozer and Cheryl L. Burbach of Hovey Williams LLP for United Country Real Estate, Inc.

Christopher B. Colwell, pro se.

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Before Seeherman, Zervas and Walsh, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

United Country Real Estate, Inc., by change of name from First Horizon Corporation,[1] has opposed the application

[1] After the institution of this proceeding opposer's name was changed, and this change was recorded in the Assignment Division of the USPTO. The Board changed the captioning of this proceeding on May 10, 2005 to reflect the change of name.

of Christopher B. Colwell to register REALTY UNITED, with the word REALTY disclaimed, as a mark for "franchising services, namely, rendering technical assistance to others in the establishment and or operation of real estate brokerage businesses and associated services."[2] As grounds for opposition, opposer has alleged that it, or its predecessors in interest, has continuously used the trademarks UNITED, UNITED COUNTRY and UNITED NATIONAL REAL ESTATE and design, or variations thereof, for real estate brokerage services since prior to the filing date of applicant's application; that opposer is the owner of registrations for the marks UNITED for "real estate brokerage services,"[3] UNITED COUNTRY for a "real estate magazine"[4] and for "real estate brokerage services"[5] and UNITED COUNTRY and design, as shown below, for "real estate brokerage services";[6]

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[2] Application Serial No. 78181779, filed November 5, 2002, pursuant to Section 1(b) of the Trademark Act (intent-to-use).

[3] Registration No. 1109683, issued December 19, 1978; Section 8 & 15 affidavits accepted and acknowledged; renewed.

[4] Registration No. 1770019, issued May 11, 1993; Section 8 & 15 affidavits accepted and acknowledged; renewed.

[5] Registration No. 2186596, issued September 1, 1998. Opposer submitted a status and title copy of this registration, prepared by the USPTO on November 3, 2003, with its notice of opposition filed on November 12, 2003. Consequently, the copy of the registration does not indicate whether a Section 8 affidavit was subsequently filed. In accordance with Board practice in such circumstances, we have ascertained from Office records that Section 8 & 15 affidavits were accepted and acknowledged.

[6] Registration No. 2188368, issued September 8, 1998. Opposer submitted a status and title copy of this registration, prepared by the USPTO on November 7, 2003, with its notice of opposition filed on November 12, 2003. Consequently, the copy of the registration does not indicate whether a Section 8 affidavit was

that opposer is the owner of a family of marks bearing the common term UNITED in the real estate brokerage field; that opposer provides its real estate brokerage services through its affiliated licensees and franchisees throughout the United States, and has provided franchising services including technical and other supporting services to its licensees and franchisees; and that applicant's use of the mark REALTY UNITED is likely to cause confusion with opposer's UNITED family of marks, including UNITED, UNITED COUNTRY and UNITED NATIONAL REAL ESTATE. The notice of opposition was accompanied by status and title copies of opposer's pleaded registrations, and therefore these registrations are of record. See Trademark Rule 2.122(d)(1).[7]

In his answer, applicant admitted that "opposer has continuously used the trademarks UNITED COUNTRY and UNITED

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subsequently filed. We have therefore ascertained that Section 8 & 15 affidavits were accepted and acknowledged.

[7] Opposer also pleaded ownership of Registration No. 1348533 for UNITED NATIONAL REAL ESTATE and design for "real estate brokerage services," but Office records show that this registration expired pursuant to Section 9 of the Trademark Act. While this

NATIONAL REAL ESTATE for real estate brokerage services from a date prior to the filing date or the claimed date of first use of the opposer application"; that opposer is the owner of Registration Nos. 1109684, 1348533, 1770019, 2186596 and 2188368; that "Opposer has spent substantial sums of money in advertising and promoting its real estate magazine distributed under the UNITED COUNTRY mark"; that "Opposer has spent substantial sums of money in advertising and promoting its real estate brokerage services rendered under the UNITED COUNTRY service mark" and that "Opposer has spent substantial sums of money in advertising and promoting its real estate brokerage services rendered under the UNITED COUNTRY AND DESIGN service marks"; that "Opposer is owner of marks UNITED, UNITED COUNTRY, UNITED COUNTRY AND DESIGN, and UNITED NATIONAL REAL ESTATE AND DESIGN, all marks being registered in International Class 36"; that "Opposer, using the marks UNITED COUNTRY and UNITED COUNTRY AND DESIGN provides its real estate services through affiliated licensees and franchisees spanning the United States, and that Opposer, under these marks, has provided franchising services including technical and other supporting services to its licensees and franchisees" prior to applicant's filing date; that "Opposer, itself or through its licensees or franchisees has used the marks UNITED COUNTRY and UNITED

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registration has been given no consideration, opposer has

COUNTRY AND DESIGN throughout the United States, and as a result of such use, the advertising of these marks and the rendering of real estate brokerage services, said marks have acquired substantial reputation and goodwill as indicating the Opposer as the source of the real estate brokerage services in connection with the above mentioned mark"; and that applicant "provides services in regard to franchising, and that its franchisees or licensees provide general real estate brokerage services to the public." Applicant has otherwise denied the salient allegations of the notice of opposition. We note that applicant has also, in denying many of these allegations, included argument and/or further explanation for his denials. Applicant has also submitted a number of exhibits with his answer; such exhibits cannot be made of record in this manner.

The record includes, by operation of the rules, the pleadings and the file of the opposed application. Only opposer has submitted evidence, which consists of the trial testimony, with exhibits, of Louis Francis, opposer's president; applicant's responses to certain of opposer's interrogatories; applicant's responses to certain of opposer's requests for admission; opposer's four pleaded registrations for UNITED, UNITED COUNTRY and UNITED COUNTRY and design, as set forth above, status and title copies of

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submitted testimony that the mark is still in use.

which were submitted with opposer's notice of opposition;[8] certain printed publications; and copies of certain decisions and/or orders of the Courts and the Board, submitted as official records pursuant to Trademark Rule 2.122(e).[9]

Only opposer filed a brief. An oral hearing was not requested.

Opposer's predecessor was founded in 1925 as United Farm Agency. In 1986, United National Real Estate was formed, through an asset purchase of the previous company. At that point the company used the marks United Farm, United National, United and United Commercial. In 1990 opposer First Horizon Corporation, doing business as United National Real Estate, acquired the assets of United National Real Estate, Inc. and later changed its name to United Country Real Estate, Inc. Some franchises continue to operate under the mark United National, while the majority use the mark United Country Real Estate. Since 1925 opposer or its

[8] Although opposer also submitted a copy of Registration No. 1348533 for UNITED NATIONAL REAL ESTATE and design with its notice of reliance that was filed on October 13, 2005, as noted in footnote 7, this registration has expired.

[9] In its brief opposer states that the record consists of 57 exhibits, which it enumerates. However, it is clear that opposer made of record additional exhibits, including applicant's responses to certain requests for admission which opposer specifically refers to in its brief. We therefore treat all the materials which opposer properly made of record as being of record, not just those exhibits which opposer listed in section III of its brief.

predecessors have used the mark UNITED in one form or another.

Between 1925 and 1975 the company enjoyed rapid growth. Its network of independent brokers increased in size; as of January 1, 2001 opposer had 323 franchisees, and as of the end of 2005 the number had reached 500. These franchisees are located throughout the United States, in 35 states. Opposer offers such services to its franchisees as marketing tools (catalogs, advertisements, website, signs, brochures) and technical support (help with their computer systems). Opposer has marketed its franchising services through advertisements in real estate publications, franchise sales teams that call on brokers, direct mail to real estate brokers, trade shows, real estate conventions, and its website.

The only information we have about applicant is from his discovery responses and admissions that were made of record by opposer. Applicant is the founder and owner of Realty United, LLC and the owner of Realty United—Triangle, which provides real estate brokerage/consulting services. Applicant uses or will use his mark in connection with the promotion and pending sale of real estate franchising services; franchisees will offer real estate brokerage services using applicant's mark REALTY UNITED as part of their trade names, for example, "Realty United—Triangle."

Applicant did not make any use of the name or mark REALTY UNITED prior to October 28, 2002. At the time applicant adopted his mark, he was aware of opposer's use of its mark. As of July 5, 2005, the date applicant responded to opposer's interrogatories, only one real estate brokerage, Realty United-Triangle, was associated with applicant. As noted above, this brokerage is owned by applicant. As of that date, applicant had not entered into any licensing or franchising agreements, and no franchises existed. Applicant has not had any purchasers of its franchising services, although it has had purchasers of its real estate brokerage services. Applicant offers his services in the Raleigh-Durham-Chapel-Hill area (the "Triangle" area) of North Carolina. Applicant has used his mark on or in connection with marketing postcards, websites, signs, press releases and classified ads, although it is not clear whether such uses are with respect to his real estate brokerage services or are for the advertising of his franchising services.

Priority is not in issue in view of opposer's registrations, which are of record. King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer began using its various UNITED marks for both real estate

brokerage services and franchising services prior to the earliest use date that could be claimed by applicant.[10]

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In this case, opposer has identified three factors that are relevant: similarity of the marks, similarity of the services, and similarity of the channels of trade.

The first du Pont factor is the similarity of the marks. Opposer has pleaded ownership of, and has submitted registrations and testimony regarding several marks containing or consisting of the word UNITED. Because the mark UNITED per se is the closest mark to applicant's mark, UNITED REALTY, we will concentrate our analysis on a comparison of opposer's mark UNITED with UNITED REALTY. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood

[10] As noted, applicant has admitted that he did not begin using his mark prior to October 28, 2002. In an answer to an interrogatory, made of record by opposer, applicant claimed he began using the mark REALTY UNITED on November 5, 2002. It is not clear from this response whether this use was in connection with the franchising services identified in his application, rather than real estate brokerage services. In view of the clear admission that he made no use of the mark prior to October 22, 2002 whether or not he used the mark in November 2002 has no effect on the question of priority.

of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In applicant's mark, UNITED REALTY, the term UNITED is clearly the dominant element. Applicant's franchising services, as shown by his identification, as well as the information he provided in discovery, deal with real estate brokerage, and he has provided a disclaimer of "realty" because of the descriptiveness of this term. Opposer has also submitted dictionary definitions of "realty" showing that this word means "real estate."[11] Thus, the word REALTY in applicant's mark does not serve to distinguish his mark from opposer's; purchasers and prospective purchasers will view the word UNITED in his mark as the portion with source-indicating significance. Accordingly, the marks UNITED and UNITED REALTY, when considered in their entireties, are virtually identical in appearance, pronunciation, connotation and commercial impression. This du Pont factor favors a finding of likelihood of confusion.

[11] See, for example, Webster's New World College Dictionary, 3d ed. © 1996.

The next du Pont factor is the similarity of the services. Applicant has admitted that his identified franchising services and real estate brokerage services are related. Request for Admission No. 12 (Opposer's exhibit No. 63). Further, applicant has admitted that "applicant's agreements with REALTY UNITED real estate brokerage franchises include the right for the real estate brokerage franchises to use the mark REALTY UNITED in connection with their real estate brokerage services." Request for Admission No. 10 (Opposer's exhibit No. 62). Moreover, the record shows that independently owned real estate brokerage offices may become franchisees of real estate brokerage companies, so that they can take advantage of the more national marketing tools that a larger company can offer, including referrals from customers who are seeking to obtain a property in a particular location. Opposer, in fact, advertises its franchising services to real estate brokerage offices in the same catalogs in which it offers its real estate brokerage services. Opposer's witness has testified that brokerage services and franchising services are interconnected, in that real estate brokerage services are used by franchisees, and those same brokerage services are used to market the franchise system. The foregoing evidence and admissions are sufficient to demonstrate the relatedness

of applicant's franchising services and opposer's real estate brokerage services.

However, in addition to the similarity of opposer's real estate brokerage services, which are the subject of its registration for UNITED, and applicant's identified franchising services for the operation of real estate brokerage businesses, the evidence also shows that opposer renders franchising services under the mark UNITED. In particular, Exhibit 15 to the Francis deposition prominently features UNITED as a trademark as part of an advertisement seeking franchisees. Thus, applicant's services are not only closely related to opposer's real estate brokerage services, but they are legally identical to opposer's franchising services. The factor of the similarity of the services favors a finding of likelihood of confusion.

The third du Pont factor is the similarity of channels of trade. Since both opposer's and applicant's franchising services may be offered to real estate brokerage businesses, the channels of trade must be deemed to be the same. Further, real estate brokerage businesses, the consumers of applicant's franchising services, would, because they are in the business, be exposed to opposer's real estate brokerage services. This factor, too, favors opposer.

Opposer has identified only the above three factors as being relevant to our decision of the issue of likelihood of

confusion. To the extent that other du Pont factors are applicable, we find that they are either neutral or that they favor a finding of likelihood of confusion. For example, there is no evidence of any third-party use of UNITED marks. On the contrary, opposer has submitted evidence that it has obtained judgments enjoining the use of UNITED for real estate brokerage services. See United National Real Estate, Inc. v. Elwood R. Morgan, Civ. Action No. 89-5421 (ED Pa Nov. 28, 1990); United National Real Estate, Inc. v. Andisch, Inc. et al, Civ. Action No. 88-C-539 (D Col June 30, 1988); and First Horizon Corp. v. Tim Singleton et al, Civ. Action No. 1:96CV000011LMB (Sept. 18, 1996). There is also no evidence of actual confusion, but there is no evidence that applicant has obtained any franchisees, nor can we determine whether applicant has actually advertised or marketed his franchising services, or if he has, to what extent. Therefore, we cannot conclude that there has been sufficient use or advertising of applicant's mark for such services that, if confusion were likely to occur, it would have occurred.

We recognize that the relevant class of purchasers for franchising services in the field of real estate would be real estate brokers, and that such purchasers would be more sophisticated and careful than the general public. However, given that applicant's franchising services and opposer's

franchising services are legally identical, and the marks are virtually identical, in that the additional word REALTY in applicant's mark has no source-indicating significance, even sophisticated and careful purchasers are likely to be confused. As for opposer's real estate brokerage services, given the close relationship between such services and franchising services in the field of real estate brokerage, sophisticated and careful purchasers are likely to believe that there is a connection as to source between these services if they are offered under such similar marks.

After considering all the du Pont factors on which there is evidence, we find that applicant's use of UNITED REALTY for "franchising services, namely, rendering technical assistance to others in the establishment and or operation of real estate brokerage businesses and associated services" is likely to cause confusion with opposer's mark UNITED for real estate brokerage services and for franchising services.

Decision: The opposition is sustained.